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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/584,805	05/31/2000	Peter M. Redling	YCI-0102	2289

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EXAMINER

LONSBERRY, HUNTER B

ART UNIT	PAPER NUMBER
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2623

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/21/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/584,805

Applicant(s)

REDLING ET AL.

Examiner

Hunter B. Lonsberry

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/29/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 18-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 18-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/18/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to the amended claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-11 and 18-29 rejected under 35 U.S.C. 103(a) as being unpatentable over Hattori et al. (US Pat App Pub No 2002/0066097) in view of Alexander et al (US 6,137,931 B1).

Regarding claim 1, Hattori discloses "information broadcasting system using a digital broadcasting which can multiplex data of programs and data other than the programs and transmit the multiplexed data, comprising a transmitting side apparatus for multiplexing advertising information added with link information indicative of a linking method of the advertising information and detailed information regarding an advertising and the detailed information to a broadcasting signal and transmitting the multiplexed information to a viewer" (Paragraph 0028). The claimed limitation of "transmitting the icons and

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associated advertising information to the set top communications box” is met by Figures 2 and 3. “In the broadcasting station 21, a program is produced and video/audio signals corresponding to the program are compressed and encoded by, for example, MPEG-2, so that they are digitized and this program material is accumulated in the server 41 of the up-link system 22. The advertising information added with a target ID for specifying a viewer class as a target of goods and services regarding the advertising and the advertising detailed information as more detailed information regarding the goods and services are accumulated in the server 42. The advertising information and the advertising detailed information are data of any one or more of a video image, audio, animation, a still image, an icon, a text, and the like” (Paragraph 0109). “In case of obtaining the detailed information through the Internet 32, the accessing method of the detailed information associated to the advertising information is specified by the link information included in the advertising information. For example, the link information includes the address information of a client such as URL (Uniform Resource Locator) of the detailed information homepage 33 of the Internet 32” (Paragraph 0112). The claimed limitations of “displaying an icon on the television screen using the set top communications box” and “detecting an input signal indicating that the displayed icon has been selected with an input device for the set top communications box” are met by Figure 5A and 6. “When the advertising icon 81 is displayed, if the viewer who watches the program wants to know more detailed information, he operates the commander 27 and clicks the advertising icon 81. Whether the icon 81 has been clicked or not,

namely, the presence or absence of the operation to request the display of the advertising detailed information is determined (step S5). When there is no display request of the advertising detailed information, the processing routine advances to step S7. In step S7, a check is made to see if a display end time of the advertising icon 81 has come. When the display end time comes, the display of the advertising icon 81 is turned off in step S8 and the processing routine is finished. A display time of the advertising icon is controlled by, for example, a timer" (Paragraph 0133). The claimed limitation of "wherein the advertising information associated with the displayed icon is targeted based on information of the subscriber" are met by Figure 5A. The advertisements are targeted based on viewer attributes, such as sex, age, district and hobbies. Since the advertisements are based on viewer attribute, they are not based on the television program being displayed. "The target ID is specified in a manner similar to the viewer attribute information registered in an IC card unit of each receiving terminal. That is, the target ID is used to specify a range of consumer or purchase layer to which the enterprise wants to provide the goods and services concerning the advertising. Specifically speaking, the target ID has information such as sex, age, district, hobby, and the like. In the broadcasting signal, the target ID is added to the head of a series of advertising data. For example, a viewer attribute is registered in an IC card which is handed to the subscriber after he made a contract of the digital broadcasting" (Paragraph 0110). "The target ID of the preserved and received advertising information is collated with the viewer attributes (sex, age, district, etc.) which have previously

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been recorded in the IC card unit 66 and the advertising information in which both of them coincide is selectively read out from the storing device 71 (step S3). The extracted advertising information data is supplied the OSD control unit 70 and the advertising icon is displayed in the picture plane. For example, as shown at the top stage in FIG. 6, an advertising icon 81 is displayed in a part of a picture plane 80 which is displaying the program (step S4).” (Paragraph 0132). The claimed limitation of “retrieving the advertising information associated with the selected icon with the set top communications box after detecting that the icon was selected” is met by Figures 5A-5C and 6. “The advertising detailed information is video and/or audio information of the contents to describe in more detail goods and services which are provided to the viewer. As a method of providing the advertising detailed information, as shown in the construction of FIG. 3, a method of multiplexing it to a digital broadcasting signal and a method of providing it from an information providing station other than the broadcasting signal are prepared. In this example, the detailed information is provided from the detailed information homepage 33 as an information providing station through the access point 31 and Internet 32 as shown in FIG. 2 and as mentioned above. When the advertising detailed information is transmitted by the broadcasting signal, an accessing method of the detailed information in the broadcasting signal associated to the advertising information is specified by the link information included in the advertising information. For instance, a packet ID including the advertising detailed information is designated. In case of obtaining the detailed information through the Internet 32, the accessing method of the

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detailed information associated to the advertising information is specified by the link information included in the advertising information. For example, the link information includes the address information of a client such as URL (Uniform Resource Locator) of the detailed information homepage 33 of the Internet 32” (Paragraphs 0011-0012; See Paragraphs 0133-0134). The claimed limitation of “displaying the advertising information on the television screen with the set top communications box” is met by Figure 6. “The OSD control unit 70 is controlled by the main control unit 65. In the OSD control unit 70, an image such as a menu picture plane or the like is superimposed. The processed video signal is displayed as a picture plane. For example, in case of using an advertising icon as advertising information, the main control unit 65 controls the OSD control unit 70 and displays the advertising icon into the picture plane for a predetermined time” (Paragraph 0127; See paragraph 0133).

With respect to the claimed limitation of “storing icons and associated advertising information on a server connected to the global computer network”, Hattori discloses storing icons and associated advertising information on a server and storing associated advertising information (i.e. the detailed information) on a server connected to the global computer network (i.e. the Internet). Hattori fail to disclose *storing icons* and associated advertising information on a server connected to the global computer network.

Alexander discloses storing icons and associated advertising information on a server connected to the global computer network (column 34, lines 10-25). The icons are the displayed ad windows 14/16 within the EPG (figure 1, column

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20, lines 39-49) and are representative of a company or product and are clickable, which result in a user downloading a webpage with related information, or enable a user to record an infomercial (column 18,. Lines 1-12, column 19, line 50-column 20, line 37), the user being able to simultaneously browse the website and view a program at the same time within the EPG (column 18, lines 38-53).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify Hattori to utilize the advertising information stored on the Internet, the links to more information on the product or company, infomercial recording features, simultaneous browsing features as taught by Alexander for the advantages of allowing a user to learn more about a product via an infomercial and website, and providing the advantage of simultaneous browsing of Internet and watching the last viewed TV program (column 18, lines 38-53).

Regarding claim 2, Hattori shows that the advertising information is displayed in a distinct frame in the screen (Paragraph 0136-0137).

Regarding claim 3, Hattori shows superimposing an icon over a television program (Paragraph 0136-0137).

Regarding claim 4, Hattori shows that if a user does not input a response to one icon, a second icon for another item is shown after a period of inactivity (Paragraph 0133; Figure 5A, Items S7 and S1-S4). After a predetermined time,

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the icon is no longer displayed. The second icon is displayed once the conditions for steps S1-S4 are satisfied.

Regarding claim 5, Hattori and Shoff fail to specifically state the length of time that elapse between the display of a first icon and the display of a second icon. Official Notice is given that it is well known and expected in the art to use a variety of time lengths between displaying successive times. This allows enough time for the user to select the icon, but not too much time in the event the user is not interested in the current icon and is waiting for the next. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Hattori and Shoff with the 1 to 5 minute duration so that a user would be provided with new icons in a timely manner in the event the user is not interested in the present icon.

Regarding Claim 6, Hattori shows transmitting advertising information to the memory of the set-top box for display on the user's screen and following detecting one of the icons has been selected, transmitting the advertising information to the set-top box (Figures 5A-5C).

Regarding claim 7, Shoff shows a variety of display methods, including displaying advertising data in the main portion of the screen in place of television program data (Figure 6).

Regarding claim 8, Hattori shows transmitting advertising information to the memory of the set-top box for display on the user's screen and following detecting one of the icons has been selected, transmitting the advertising information to the set-top box (Figures 5A-5C).

Regarding claim 9, Hattori shows that if a user does not input a response to one icon, a second icon for another item is shown after a period of inactivity (Paragraph 0133; Figure 5A, Items S7 and S1-S4). After a predetermined time, the icon is no longer displayed. The second icon is displayed once the conditions for steps S1-S4 are satisfied.

Regarding claim 10, Hattori and Shoff fail to specifically state the length of time that elapse between the display of a first icon and the display of a second icon. Official Notice is given that it is well known and expected in the art to use a variety of time lengths between displaying successive items. This allows enough time for the user to select the icon, but not too much time in the event the user is not interested in the current icon and is waiting for the next. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Hattori and Shoff with the 1 to 5 minute duration so that a user would be provided with new icons in a timely manner in the event the user is not interested in the present icon.

Regarding claim 11, Hattori shows superimposing an icon over a television program (Figure 6).

Regarding claim 18, the claimed limitation of “downloading by the set-top box an advertising information associated with the advertising icon from the advertising server through the Internet” is met by Figures 2 and 3 (See that discussed for claim 1). The claimed limitations of “displaying by the set-top box a television program on a television screen and the downloaded advertising icon on the television screen at the same time” and “receiving through an input device

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for the set-top box a user selection of the displayed icon” are met by Figure 5A and 6. The claimed limitation of “wherein the advertising information associated with the displayed icon is targeted based on information of the subscriber” are met by Figure 5A. The advertisements are targeted based on viewer attributes, such as sex, age, district and hobbies. Since the advertisements are based on viewer attribute, they are not based on the television program being displayed. The claimed limitation of “displaying by the set-top box the advertising information associated with the selected icon on the television screen” is met by Figure 6. With respect to the claimed limitation of “downloading by a set-top box an advertising icon from an advertising server through the Internet”, Hattori discloses storing icons and associated advertising information on a server and storing associated advertising information (i.e. the detailed information) on a server connected to the Internet.

Hattori fail to disclose downloading by a set-top box an advertising *icon* from an advertising server through the Internet.

Alexander discloses storing icons and associated advertising information on a server connected to the global computer network (column 34, lines 10-25). The icons are the displayed ad windows 14/16 within the EPG (figure 1, column 20, lines 39-49) and are representative of a company or product and are clickable, which result in a user downloading a webpage with related information, or enable a user to record an infomercial (column 18,. Lines 1-12, column 19, line 50-column 20, line 37), the user being able to simultaneously browse the

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website and view a program at the same time within the EPG (column 18, lines 38-53).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify Hattori to utilize the advertising information stored on the Internet, the links to more information on the product or company, infomercial recording features, simultaneous browsing features as taught by Alexander for the advantages of allowing a user to learn more about a product via an infomercial and website, and providing the advantage of simultaneous browsing of Internet and watching the last viewed TV program (column 18, lines 38-53).

Regarding Claims 19-20, Hattori shows the icon has an associated link pointing to the associated advertising information, the step of downloading by the set-top box an advertising icon includes requesting a download of the associated advertising information from the advertising server using the associated link when the user has selected the displayed icon, the step of downloading by the set-top box an advertising icon includes: after the user selection is received, requesting a download of the associated advertising information from the advertising server; and receiving the requested advertising information by the set-top box (see claim 1).

Regarding claim 21, Hattori shows displaying the advertising information includes displaying the television program being displayed on the television screen in a first frame and displaying the advertising information in a second frame different from the first frame (Paragraph 0136-0137).

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Regarding claim 22, Hattori shows that if a user does not input a response to one icon, a different icon for another item is shown after a period of inactivity (Paragraph 0133; Figure 5A, Items S7 and S1-S4). After a predetermined time, the icon is no longer displayed. The second icon is displayed once the conditions for steps S1-S4 are satisfied.

Regarding claim 23, the recited limitations are met by that discussed above for claims 1 and 18.

Regarding claim 24, Hattori shows after the user selection is received from the input device, the processor requests a download of the associated advertising information from the advertising server and receives the requested advertising information for display on the television screen (see claim 1).

Regarding claims 25-26, Hattori shows the processor displays a different icon on the television screen when no user selection is received from the input device for a selected period of time and that if a user does not input a response to one icon, a different icon for another item is shown after a period of inactivity (Paragraph 0133; Figure 5A, Items S7 and S1-S4). After a predetermined time, the icon is no longer displayed. The second icon is displayed once the conditions for steps S1-S4 are satisfied.

Regarding claims 27-29, Hattori and Shoff fail to specifically state the information of the subscriber comprises location information of the subscriber. Official Notice is given that it is well known in the art to use location information of the subscriber. This allows advertisers to further segment the market for as to increase the effectiveness of an advertisement. Therefore, it would have been

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obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Hattori and Shoff the information of the subscriber comprising location information of the subscriber for the stated advantage.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hunter B. Lonsberry whose telephone number is 571-272-7298. The examiner can normally be reached on Monday-Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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HBL



Hunter B. Loxberry
Patent Examiner
Art Unit 2623